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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/769,718

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Thomas Stephan

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04/06/2009

ACCENTURE CHICAGO 28164

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CHICAGO, IL 60610

EXAMINER

WONG, ERIC TAK WAI

ART UNIT

PAPER NUMBER

3693

MAIL DATE

DELIVERY MODE

04/06/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/769,718

Applicant(s)

STEPHAN ET AL.

Examiner

ERIC T. WONG

Art Unit

3693

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 8, 17 and 33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 8, 17, and 33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/5508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 8 and 33 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 8,

The claim recites “wherein weightings from said industry expert for each of said measurement categories are not input into said computer analysis tool”. The limitation renders the claim indefinite because claim 1, from which the claim depends, recites “inputting said weightings into a computer analysis tool.” Claim 33 is rejected by virtue of its dependence on claim 8.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 8, 17, 33 rejected under 35 U.S.C. 103(a) as being unpatentable over Brown (US PG-Pub 2005/0010469) in view of Grey ("An analytic approach for quantifying the value of e-business initiatives").

Regarding claim 1,

Brown teaches interviewing an industry expert thereby collecting a weighting determined by said industry expert for each of a plurality of evaluation categories before asking evaluation questions associated with said evaluation categories (see paragraphs 44 and 50); collecting responses from an industry expert to evaluation questions; inputting weightings and said responses into a computer analysis tool (see abstract); and reporting a computer generated analysis to said industry expert contemporaneously with said interviewing step, said inputting step, and said analyzing step (see abstract).

Brown does not explicitly teach wherein said evaluation categories comprise categories of value chain steps and performance attributes. Grey teaches a value chain consulting tool which evaluates categories of value chain steps and performance attributes. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to have modified the computer analysis tool of Brown with wherein said evaluation categories comprise categories of value chain steps and performance attributes. The modification would have merely been the application of a known technique to a known method ready for improvement yielding predictable results. Grey further teaches wherein the analysis comprises separate analyses for each of said value chain steps and said performance attributes.

Regarding claims 17 and 33,

See rejection of claim 1 above.

The claims additionally recite that the value chain steps comprise profile assessment, asset allocation, asset selection, order generation, and reporting and monitoring and that the performance attributes comprise automatization scalability, and outsourcing and insourcing.

As discussed in the rejection of claim 1 above, Grey teaches a value chain analysis of a business. It was well known in the art that this type of analysis involves identifying primary activities (eg. inbound logistics, operations, outbound logistics, marketing & sale, service) and secondary support activities (eg. firm infrastructure, human resource management, technology development, procurement) (evidenced by Porter figure, cited in prior Office action). It was also well known in the art at the time of invention that a portfolio management firm's support activities may comprise automatization, scalability, and outsourcing and insourcing. Therefore, it would have been obvious to modify the value chain analysis of Grey to include those primary and secondary activities which are relevant to portfolio management. In fact, Grey points out that the disclosed modeling approach and the Risk and Opportunity assessment methodology can be applied across industries (see pg. 485). The modification would have merely been the application of a known technique, ie. Porter's value chain analysis, to a known method, ie. portfolio management processes, yielding predictable results.

The claims additionally recite the following limitations which are disclosed by Brown:

an automatic flag for each report identifying levels of improvement potential (see paragraph 46).

a value tree report, comprising groupings of some of said response inputs into measurement categories thereby combining the responses into an effectivity result, and a list of key drivers or recommended solutions based on a comparison of said effectivity results and predetermined values for each measurement category (see paragraphs 46-48).

Response to Arguments

5. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ERIC T. WONG whose telephone number is 571-270-3405. The examiner can normally be reached on Monday-Friday 9:00AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James A. Kramer can be reached on 571-272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James A. Kramer/
Supervisory Patent Examiner, Art Unit 3693

ERIC T. WONG
Examiner
Art Unit 3693

March 9, 2009